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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,239	08/03/2001	Cheryl Steed	4232/2	7541

7590                    04/18/2003

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EXAMINER

PATTERSON, MARIE D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 04/18/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

	Application No.	Applicant(s)
	09/922,239	STEED ET AL.
	Examiner	Art Unit
	Marie Patterson	3728

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 17 March 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1,2,4,18-23 and 29-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,4,18-23 and 29-48 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a)  The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

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1.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4, 18-23, and 29-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oakley (4864740) in view of Ogden (5388349), Cintron (5675914), and Watt (4808458)..

Oakley shows an insert comprising a nonwoven fabric layer (4), a nonslip material layer/non-slip surface (12), an ingredient layer (10), bonding the layers together (column 4 lines 5-20), and treating the top fabric layer (column 3 lines 14-16) substantially as claimed except for the exact coefficient of friction for the top nonwoven layer and the material for the top layer. Ogden teaches adjusting the coefficient of friction of the top surface of an insert to above 0.5 (see column 11 lines 50-57) to provide less sliding movement of a wearers sock to provide an enhanced feeling of control. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the top have a coefficient of friction of between 0.52 and 0.82 or 0.62 and 0.82 which is above 0.5 as suggested by Ogden, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. It would have been obvious to provide the top layer with a coefficient of friction of above 0.5 as taught by Ogden in the insert of Oakley to increase the feeling of control of the

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footwear. Cintron teaches the well known and conventional use of suede materials for the top layer of insoles (column 3 lines 1-2). Watt teaches forming a suede-like material which has vertically disposed fibers (18). It would have been obvious to use a suede material as is well known and taught by Cintron and to use the suede material with vertically disposed fibers as taught by Watt for the nonwoven layer of the insert of Oakley as modified above to provide a soft and comfortable feel.

In reference to claims 19, 35, 38, and 40 a comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. *In re Fessman*, 489 F2d 742, 180 U.S.P.Q. 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug*, 333 F2d 905, 142 U.S.P.Q. 161 (CCPA 1964). In an ex parte case, product-by-process claims are not construed as being limited to the product formed by the specific process recited. *In re Hirao et al.*, 535 F2d 67, 190 U.S.P.Q. 15, see footnote 3 (CCPA 1976).

In reference to claims 22, 32, and 33, Oakley suggests the use of cohesive coatings for the non slip layer see column 3 lines 60-64. The term "cohesive" is defined as "sticking together, causing or characterized by cohesion" and "cohesion" is defined as "the act or condition of cohering, tendency to stick together" (Webster's New World Dictionary 3<sup>rd</sup> College Edition). Adhesive coatings clearly are cohesive in that they would "adhere" to themselves, also adhesive coatings clearly have a high coefficient of friction in that they prevent sliding. Also, it is noted that "tacky" is defined as "sticky" and "sticky" is defined as "tending to cling to anything touched" (Webster's New World

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Dictionary 3<sup>rd</sup> College Edition). Therefore the adhesive coatings which are tacky, i.e. tend to stick to anything (including itself) touched, disclosed by Oakley clearly are considered to be "a cohesive coating...defining said non-slip surface" as claimed.

In reference to claims 34, 37, and 41 Oakley as modified above discloses the claimed invention except for the exact amount of film. It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the cohesive coating as a film in the amount of between 1 and 300 (or between 5 and 250) milligrams per square inch, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

In reference to claims 36, and 39, the exact pattern of the cohesive coating, the specific pattern/method of extrusion/lamination appear to have no importance as Oakley does not specify any required pattern. It would have been obvious to use any known pattern/method of extrusion including melt-blown, vertical spiral, horizontal spiral, and/or vertical/horizontal comb slot-coat. The presence of claims 36 and 39 is evidence that the invention is indifferent, i.e. there is no criticality, to the specific one of the conventional patterns/methods.

#### ***Response to Arguments***

4. Applicant's arguments filed 3/17/03 have been fully considered but they are not persuasive.

In response to Applicant's piecemeal analysis of the references, it has been held that one cannot show non-obviousness by attacking references individually where, as

here, the rejections are based on combinations of references. In re Keller, 208 USPQ 871 (CCPA 1981).

In response to applicants' arguments directed towards "vertical" fibers, Watt clearly teaches such fibers in a suede material and Cintron has now been applied as requested by applicant as showing that it is well known and conventional to use suede materials for the top layer in insoles. It is also noted that the additionally cited references to Barsorian (5896677) and Bray, Jr. (6112432) also show/teach the conventional and well known use of suede materials for the top layers of insoles.

***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner \_\_\_\_\_ of Art Unit \_\_\_\_\_ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to Valerie Douglas at (703) 308-1337.

Check out our web-site at "[www.uspto.gov](http://www.uspto.gov)" for fees and other useful information.



Marie Patterson  
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Art Unit 3728